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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/509,377
Filing Date: August 28, 2000
Appellant(s): MATASOV, SERGEY

Dr. Sergey Matasov
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 23, 2008 appealing from the Office action mailed February 12, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct in part.

It is noted that page 10 of the Appeal Brief includes another Claims Appendix described as "clean copy of claims with corrected references". Because this is not a proper part of an Appeal Brief, this paper is being considered as a second After Final Amendment. As indicated by the Advisory Action attached hereto, this Amendment will NOT be entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.¹

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is partially correct¹. The changes are as follows: the "Objection concerning identification of reference on SU 1522466 in the specification" is not a ground of rejection and is not presented for review. In fact, this is no longer an objection. In addition, the rejections under 35 USC 102(d) should cover claims 1, 4, 5, 10, 11, 21 and 22. Furthermore, the "Indication concerning the allowance of claims 12, 17 and 18" is not a ground of rejection.

Thus the Grounds of Rejection to be Reviewed on Appeal are:

- 1) Whether claims 11-13, 15, 17, 18 and 22 are indefinite under 35 USC 112, second paragraph.
- 2) Whether claims 1, 4, 5, 10, 11, 21 and 22 are unpatentable under 35 USC 102(d) as being anticipated by Matasov (SU 1522466).
- 3) Whether claims 13 and 15 are unpatentable under 35 USC 103 over Matasov in view of Avitall (U.S. Pat. 5,441,483), and Matasov in view of Wilk (U.S. Pat. 5,396,879).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief (section 8, page 7) is correct.

(8) Evidence Relied Upon

SU 1522466	Matasov	7-1989
5,441,483	Avitall	8-1995
5,396,879	Wilk et al.	3-1995

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

REJECTIONS UNDER 35 U.S.C. 112, SECOND PARAGRAPH

Claims 11-13, 15, 17, 18 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

¹ According to MPEP 1205.02, the brief of a *pro se* appellant should be considered as long as substantially complies with items (i) through (iv) and (vii) through (x) of the items specified in 37 CFR 41.37(c)(1). Leniency has been given for the Summary of the Invention and the Grounds of Rejection to be Reviewed on Appeal.

Claim 11 is indefinite because the term “the tip” lacks antecedent basis. Claim 11 depends from claim 4 which in turn depends from claim 1. Since neither of claim 1 or 4 recite a “tip”, it is unclear as to what this term is referring.

Claims 12, 13, 15 and 17 are multiple dependent claims which in part depend from canceled claims (i.e., 2, 3 and 6).²

Claim 18 is indefinite because the terms “the biopsy forceps”, “the distal end” and “the hermetic tube” all lack antecedent basis. Claim 18 depends from claims 11, 4 and 1, none of which recite these terms.

Claim 22 in part depends from canceled claim 6². Furthermore, it is indefinite because the terms “the distal preservative” and “the tip” lack antecedent basis. Claim 22 properly depends from claims 4 and 5, both of which depend from claim 1. None of these claims recited the terms.

REJECTIONS UNDER 35 U.S.C. 102(d)

Claims 1, 4, 5, 10, 11, 21 and 22 are rejected under 35 U.S.C. 102(d) as being anticipated by Matasov (Inventors Certificate SU 1522466)³.

Referring to the only Figure, Matasov discloses an endoscopic tube (3) with a distal part/guided distal end (part of tube 3 in the vicinity of tip 6) comprising a disposable cartridge (4) located on the distal part of the endoscopic tube and formed of a compact hollow cylinder (7) gathered by pleats (col.3, lines 19-24 of translation) with an unverted end (proximal, pleated end 7) which is coupled with and held on the distal part of the tube (at 9, col.3, lines 40-48).

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Inherently, because they are separate elements, there is a gap between the cylinder (7) and the endoscopic tube (3). As to claim 4, the pleats in cylinder (7) inherently from “narrowings” and “widening” within the external and internal diameters. As to claim 5, a shell/anal dilator (19) contains at least a portion of the cylinder. As to claim 10 and 22, the endoscopic tube (3) inherently comprises an outer protective tube (that which is shown in the Figure) which meets the limitation of a preservative hermetically fixed to the distal tip (6) and proximal part (areas) of the tube. As to claim 11, the tip (6) inherently has a protective glass by nature of the Matasov device being an endoscope. As to a channel (claim 21), note third full paragraph of page 1 of the original specification (filed March 27, 2000) which describes the endoscope of Matasov (SU 1522466) as having a gas and liquid supply channel.

REJECTIONS UNDER 35 U.S.C. 103(a)

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matasov in view of Avitall (U.S. Pat. 5,441,483).

Matasov discloses a bendable distal portion (indicated by the bending control knob on control block 2) but fails to disclose the particulars of the bending mechanism. Avitall discloses a bending mechanism that incorporates internal transverse pleats in the external cover, which are directed inwards (note 50, Fig. 1A). Since any bending mechanism could be used in the endoscope of Matasov without any effect of the operation of the disclosed device, it would have been obvious to one of ordinary skill in the art to have provided any known bending mechanism in the Matasov endoscope.

² Although such issue probably only warrants the label of “objection”, throughout prosecution, the Examiner had

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matasov in view of Wilk et al. (U.S. Pat. 5,396,879).

Matasov discloses a bendable distal portion (indicated by the bending control knob on control block 2) but fails to disclose the particulars of the bending mechanism. Wilk et al. disclose a bending mechanism that incorporates solenoids or hydraulic mechanisms in the distal end of the endoscope for the purpose of bending (note Figure 1 and col.3, lines 47-53). At least the solenoid would meet the limitation of “executing cylinder-piston units” since a solenoid would comprise a plunger within a cylinder. Since any bending mechanism could be used in the endoscope of Matasov without any effect of the operation of the disclosed device, it would have been obvious to one of ordinary skill in the art to have provided any known bending mechanism in the Matasov endoscope.

(10) Response to Argument

Important Note

Appellant is a *pro se* applicant from a different country and is obviously unfamiliar with patent law and practice. Throughout prosecution, the Examiner has given Appellant the benefit of the doubt in many instances, has been lenient with respect to application of the rules in a strict manner and has tried to help further prosecution within the confines of the limited time given to the Examiner. Although neither this application nor the Appeal Brief is in a perfect condition, the Examiner believes that the critical issues have been presented, the lines have been drawn, and

more luck getting Appellant to effect proper changes when the issue was in the form of a rejection.

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Appellant deserves final decision on the issues, namely with respect to the prior art. Thus, although the Board might find reading of this application difficult and confusing, the Examiner will try to clearly explain the issues in an attempt to expedite a decision by the Board.

Response to Whether claims 11-13, 15, 17, 18 and 22 are indefinite under 35 USC 112, second paragraph.

Appellant attempted to correct the issues presented by the Examiner under 35 USC 112, second paragraph in a “secondary” appendix (page 10 of the Brief) which had to be considered as an After Final Amendment. Such Amendment could not be fairly entered and is indicated as such on the attached Advisory Action. However, it would appear that Appellant’s willingness to correct such issues indicates that there is no dispute. Comments from the Examiner are therefore unnecessary.

Response to Whether claims 1, 4, 5, 10, 11, 21 and 22 are unpatentable under 35 USC 102(d) as being anticipated by Matasov (SU 1522466).

Claim 1 recites, *inter alia*, that an uneverted part (i.e., the part that is gathered and bunch up around the endoscopic tube) of the eversible tube is formed by pleats into a compact hollow cylinder having *a gap* with the distal part of the endoscopic tube. The gap is not defined in the original specification, and clearly not defined in the claim, in a manner that provides any relative size or degree. In fact, it was not pointed out until the Appeal Brief that the compact cylinder is first formed on an inner forming rod that is larger in diameter than the endoscopic tube (Brief,

³ Inventors Certificate SU 1522466 and a translation thereof was filed on January 22, 2003.

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page 5, lines 5-6). Although this fact appears to be more critical to the method of making the device, it does finally give the Examiner an idea of what Appellant intended to disclose.

However, claim 1 only requires a “gap”. It does not have to be any size or any shape, and there does not have to be any continuity to it (e.g., it does not have to extend from the proximal end to the distal end of the cylinder).

Regarding SU 1522466, Appellant argues that there is an “absence of a gap” between the uneverted part of the invaginator (eversible tube) and the endoscopic tube (Brief, page 4, lines 4-5) and cites passages from the translation of such³. However, none of citations from the translation (Brief, page 4, lines 6-24) explicitly state or even imply that there is no gap between the eversible tube and the endoscopic tube. The Examiner is aware that just because SU 1522466 does not explicitly teach or imply no gap, as broadly as claimed, it does not mean that there is one. The Examiner has based his finding of an “inherent” gap on Appellant’s description of structural properties and arrangement of the elements which will be explained below.

Appellant has evidenced from SU 1522466 that the eversible tube is "gathered" on the endoscopic tube “as pleated” in a "non-compact” manner. This means that the entire inside surface of the eversible tube will NOT lie flat against the outside surface of the endoscopic tube. Only in this circumstance would the Examiner concede there is no gap between the two. The Examiner would instead liken such pleated gathering to placement of a curtain on a curtain rod (one in which the width of the curtain is longer than the rod or the length along the rod in which the curtain occupies is shorter than the width of the curtain). The curtain will be bunched up, or gathered, and can be considered folded or "pleated". Some of the folds will be on the inside diameter of the “cylinder” formed by the gathering, some will be folded away from the rod, in

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which the fold will actually form part of the outer diameter of the "cylinder", and some will be inbetween. Between such folds, however small, there will be gaps. In other words, unless the "cylinder" is formed perfectly by causing the length between folds to be exactly the same and then compressing the folds, like an accordion, to the point where there is no space between them, there will be a "gap".

In addition, Appellant further evidences the "absence of a gap" in SU 1522466 by pointing out that the tube "cuddles" to the endoscopic tube under working pressure (Brief, page 4, line 10). Even if "cuddling" could be taken as being pressed so hard that there is no gap whatsoever (and there is no evidence to suggest it does especially in light of the remarks made immediately above), SU 1522466 further defines a state in which working pressure is reduced and "the pleated part of the tube does not cuddle to the light pipe and under the action of spring 10 is able to displace to the projection 6 on the place of tube" (Brief, page 4, lines 19-24). Thus, at least part of the time, the lack of pressure and ability of the endoscopic tube (light pipe) to move with respect to the pleated part of the tube would suggest at least a small gap between the endoscopic tube and pleated tube.

This above explanation in combination with the broad recitation ("a gap"), which essentially amounts to a space, warrants the rejection.

Regarding Appellant's remarks concerning the "essential reason rejection of claim 1" (Brief, page 5, beginning on line 18), such remarks are not true and have nothing to do with the present rejection.

Claims 4, 5, 10, 11, 21 and 22 are argued under a separate heading (Brief, page 6, lines 9-14) but such arguments are dependent on the arguments presented with respect to claim 1. Therefore, they will be considered to stand or fall with claim 1.

Response to Whether claims 13 and 15 are unpatentable under 35 USC 103 over Matasov in view of Avitall (U.S. Pat. 5,441,483), and Matasov in view of Wilk (U.S. Pat. 5,396,879).

Appellant bases the patentability of claims 13 and 15 on the patentability of claim 1 and relies on arguments previously presented. Therefore, no comment from the Examiner is necessary.

Consideration of Letter Submitted in Section 9: Evidence Appendix.

The letter filed as “evidence” for the first time on December 12, 2007 in the corrected Appeal Brief filed therewith will not be admitted pursuant 37 CFR 41.33(c)(2). In any event, the content of such letter in no way effects the pending rejections.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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